

Information Disclosure Statement

In the Final Office Action, the affidavit of Richard L. Weiner was not considered as to the merits on the ground that the affidavit is not a publication or patent. Although the affidavit would not be listed on the first page of any patent that could issue based on the present application, the Applicant understands that the affidavit has in fact been considered by the Patent Office based on the fact that the Final Office Action relies on the affidavit as a basis for rejection of the claims. The Applicant resubmits herewith the affidavit as well as a supplemental affidavit of Richard L. Weiner for (re)consideration as part of the Applicant's response to the Final Office Action.

Rejection Under 35 U.S.C. § 102(a)

Claims 1-3, 5, 6, and 9-51 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the affidavit of Richard L. Weiner. The Applicant traverses the rejection in view of the following Remarks.

It is respectfully submitted that the Weiner affidavit, and particularly any disclosure by the Applicant during his lectures, does not anticipate claims 1-3, 5, 6, and 9-51. In particular, any such disclosure by the Applicant would fail to provide an *enabling* disclosure such that it describes any invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the Applicant's invention. See *In re Paulsen*, 30 F.3d 1475, 1478, 31 U.S.P.Q.2d 1671, 1673 (Fed. Cir. 1994) (To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention [,] . . . must be enabling[,], and [must] describe . . . [the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the

invention.”). “[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.” *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F3d 1339 (Fed. Cir. 2000) (*quoting In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985)). The Applicant submits that any disclosure was merely speculative and untested. Accordingly, since the Applicant’s disclosure was not enabling and unproven at the time, it fails to provide an enabling disclosure of the claimed inventions either explicitly or impliedly.

For example, the affidavit fails to disclose, teach, or suggest a method as recited in claim 1, including particularly the step of “placing a lead having at least one electrode in the fascia” *See* Supplemental Affidavit of Richard L. Weiner, ¶ 5(a). Similar limitations as that recited in claim 1 are present in each independent claim. As another example, the affidavit fails to disclose, teach, or suggest a method as recited in claim 13, including particularly the step of “curving the introducer needle” *See* Supplemental Affidavit of Richard L. Weiner, ¶ 5(c). As yet another example, the affidavit fails to disclose, teach, or suggest the methods as recited in claims 34 and 46, which relate to the stimulation of other peripheral nerves for the treatment of other forms of peripheral nerve neuralgia. *See* Supplemental Affidavit of Richard L. Weiner, ¶ 6. It should be noted that the missing elements listed above are merely examples and that the affidavit fails to disclose, teach, or suggest many other claimed elements and steps of the present invention. Given that the Applicant’s disclosure during his lectures was so speculative and cursory, the Applicant respectfully submits that delineating each and every missing element would be unnecessary.

Accordingly, it is respectfully submitted that claims 1-3, 5, 6, and 9-51 are in allowable condition, and the rejection of the claim be withdrawn.

CONCLUSION

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

Banner & Witcoff, Ltd.

Dated: April 17, 2002

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